BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 15

Application Number: 09/450,262
Filing Date: November 29, 1999
Appellant(s): HECKERMAN ET AL.

MAILED

JUL 14 2003

GROUP 3600

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<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/21/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-4, 6-14, and 16-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8)   Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   Prior Art of Record

6,343,274   McCollom, et al   01-2002

(10)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 6-14, and 16-20 are rejected under 35 U.S.C. 102(e) as being

anticipated by McCollom et al (U.S. 6,343,274).

As per claim 1, McCollom et al teach:

A computer-implemented method comprising:

selecting an ad to be displayed on a web page as one of a plurality of ads within a current cluster, each of the plurality of ads having a selection probability *for being displayed (see column 5, lines 5-62)*.

displaying the ad selected on the web page (see column 6, lines 61-67 – column 7, lines 1-18);

detecting activation of the ad displayed (see column 6, lines 61-67 – column 7, lines 1-18); and,

transmitting information to an entity associated with the ad upon detecting activation of the ad displayed, *the transmitted information comprising information regarding the current cluster* (see column 6, lines 61-67 – column 7, lines 1-19; column 8).

As per claim 2, McCollom et al teach:

The method of claim 1, further comprising displaying a web page associated with the entity associated with the ad (see column 8, lines 3-25).

As per claim 3, McCollom et al teach:

The method of claim 1, wherein the current cluster is one of a plurality of clusters, the plurality of clusters based on information provided by at least the entity (see column 5, lines 40-56).

As per claim 4, McCollom et al teach:

The method of claim 1, wherein detecting activation of the ad display comprises detecting clicking on of the ad displayed (see column 6, lines 61-67 – column 7, lines 1-19).

As per claim 6, McCollom et al teach:

The method of claim 1, wherein at least some of the plurality of ads are related to the entity for promoting a brand image of the entity (see column 5).

As per claim 7, McCollom et al teach:

The method of claim 1, wherein the entity comprises one of: a vendor, an advertiser, an organization, and a business (see column 5, lines 40-50).

As per claim 8, McCollom et al teach:

A computer-implemented method comprising:

detecting activation of a display message, the display message associated with a current cluster and having a selection probability within the current cluster for being displayed (see column 6, lines 61-67 – column 7, lines 1-19);

transmitting information to an entity associated with the display message upon detecting activation of the display message, the information comprising information regarding the current cluster (see column 6, lines 61-67 – column 7, lines 1-19; column 8).

As per claim 9, McCollom et al teach:

The method of claim 8, wherein the current cluster is one of a plurality of clusters, the plurality of clusters based on information provided by at least the entity (see column 5, lines 40-67 – column 6).

As per claim 10, McCollom et al teach:

The method of claim 8, wherein the entity comprises one of: a vendor, an advertiser, an organization, and a business (see column 5, lines 40-50).

Claim 11 is written as a machine-readable medium but contains the same limitation as claim 1, therefore the same rejection is applied.

Claim 12 is written as a machine-readable medium but contains the same limitation as claim 2, therefore the same rejection is applied.

Claim 13 is written as a machine-readable medium but contains the same limitation as claim 3, therefore the same rejection is applied.

Claim 14 is written as a machine-readable medium but contains the same limitation as claim 4, therefore the same rejection is applied.

Claim 16 is written as a machine-readable medium but contains the same limitation as claim 6, therefore the same rejection is applied.

Claim 17 is written as a machine-readable medium but contains the same limitation as claim 7, therefore the same rejection is applied.

Claim 18 is written as a machine-readable medium but contains the same limitation as claim 8, therefore the same rejection is applied.

Claim 19 is written as a machine-readable medium but contains the same limitation as claim 9, therefore the same rejection is applied.

Claim 20 is written as a machine-readable medium but contains the same limitation as claim 10, therefore the same rejection is applied.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCollom et al (U.S. 6,343,274).

As claim 21, McCollom et al do not expressly teach, the method of claim 1, further comprising dynamically tailoring the web page based upon the transmitted information. However, lines 3-55 of column 8 teach that upon detecting that the ad displayed has been activated, the consumer program sends statistical information, (such as the number of times the user has clicked on the advertisement to obtain further information from the merchant website), to a commerce server. Once the consumer has sent all the statistical information captured from the consumer interaction, the consumer requests and receives from the commerce server, all advertisements from each merchant and in each category. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the consumer browser would be dynamically tailored to the moment the commerce server receives the statistical information and from this information, the server would customize the advertisements that are sent to the consumer. This way each consumer would receive only advertisement that is better targeted to his/her needs.

As per claim 22, McCollom et al do not expressly teach, the method of claim 1, further comprising dynamically tailoring the ad displayed base upon the transmitted information. However, lines 3-55 of column 8 teach that upon detecting that the ad

displayed has been activated, the consumer program sends. statistical information, (such as the number of times the user has clicked on the advertisement to obtain further information from the merchant website), to a commerce server. Once the consumer has sent all the statistical information captured from the consumer interaction, the consumer requests and receives from the commerce server, all advertisements from each merchant and in each category. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the consumer browser would be dynamically tailored to the moment the commerce server receives the statistical information and from this information, the server would customize the advertisements that are sent to the consumer. This way each consumer would receive only advertisement that is better targeted to his/her needs.

As per claim 23, McCollom et al do not expressly teach, the method of claim 8, further comprising dynamically tailoring a display based upon the information regarding the current cluster. However, lines 3-55 of column 8 teach that upon detecting activation of the ad displayed, the consumer program sent statistical information, (such as the number of times each advertisement for each merchant in each category is seen), to a commerce server. Once the consumer has sent all the statistical information captured from the consumer interaction, the consumer requests and receives from the commerce server, all advertisements from each merchant and in each category. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the consumer browser would be dynamically tailored to the moment the commerce server receives the statistical information and from this information, the

server would customize the advertisements that are sent to the consumer. This way each consumer would receive only advertisement that is better targeted to his/her needs.

As per claim 24, McCollom et al do not expressly teach, the method of claim 8, further comprising dynamically tailoring the display message based upon the information regarding the current cluster. However, lines 3-55 of column 8 teach that upon detecting activation of the ad displayed, the consumer program sent statistical information, (such as the number of times each advertisement for each merchant in each category is seen), to a commerce server. Once the consumer has sent all the statistical information captured from the consumer interaction, the consumer requests and receives from the commerce server, all advertisements from each merchant and in each category. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the consumer browser would be dynamically tailored to the moment the commerce server receives the statistical information and from this information, the server would customize the advertisements that are sent to the consumer. This way each consumer would receive only advertisement that is better targeted to his/her needs.

As per claim 25, McCollom et al do not expressly teach, the medium of claim 11, the method further comprising automatically changing at least one of the web page and the ad displayed based upon the information regarding the current cluster. However, lines 3-55 of column 8 teach that upon detecting activation of the ad displayed, the consumer program sent statistical information, (such as the number of times each

advertisement for each merchant in each category is seen), to a commerce server. Once the consumer has sent all the statistical information captured from the consumer interaction, the consumer requests and receives from the commerce server, all advertisements from each merchant and in each category. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the consumer browser would be dynamically tailored to the moment the commerce server receives the statistical information and from this information, the server would customize the advertisements that are sent to the consumer. This way each consumer would receive only advertisement that is better targeted to his/her needs.

As per claim 26, McCollom et al do not expressly teach the medium of claim 18, the method further comprising automatically changing at least one of a display and the display message based upon the information regarding the current cluster. However, lines 3-55 of column 8 teach that upon detecting activation of the ad displayed, the consumer program sent statistical information, (such as the number of times each advertisement for each merchant in each category is seen), to a commerce server. Once the consumer has sent all the statistical information captured from the consumer interaction, the consumer requests and receives from the commerce server, all advertisements from each merchant and in each category. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the consumer browser would be dynamically tailored to the moment the commerce server receives the statistical information and from this information, the

server would customize the advertisements that are sent to the consumer. This way

each consumer would receive only advertisement that is better targeted to his/her

needs.

(11)   Response to Argument

The Appellant argues that McCollom fails to disclose transmitting information to

an entity associated with an ad or display message upon detecting activation of the ad

or display message.

The Examiner answers that McCollom teaches a system that upon detecting

activation of an ad transmits the information to an entity associated with an ad (see

column 6, line 61 – column 7, line 19 and column 8). If the information is transmitted

immediately or some time later would not patentably distinguished the claimed invention

from the prior art.

The Appellant argues that McCollom fails to teach transmitting information

regarding the current cluster.

The Examiner answers that this feature is deemed to be inherent to the

McCollom system as lines 3-25 of column 8 teach that the consumer program sends

statistical information for the number of times each advertisement for each merchant in

each category is seen, the percentage of advertisements viewed and the total amount

of time spent viewing the advertisements. Once the consumer program has sent all the

statistical information captured from the consumer interaction, the consumer program

requests and receives from the commerce server, all advertisement for each merchant

and in each category. Therefore, it would be inherent that the McCollom system

transmits information about the current cluster or categories of advertisements viewed by the consumers.

The Appellant argues that McCollom fails to disclose transmitting information regarding the current cluster or ads having a selection probability.

The Examiner answers that this feature is deemed to be inherent to the McCollom system as columns 7 and 8 show that McCollom captures statistical information for each advertisement the consumer has viewed, such as what share of ad clicks does certain merchant get compared to other merchants, and uses this information to calculate which advertisements should be sent to the consumer based on probability. The advertisement that is displayed to the customers would have a selection probability with a bias of showing certain advertisements over others based on consumer statistical information.

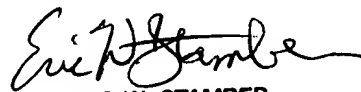The Appellant argues that McCollom does not teach dynamically tailoring a web page.

The Examiner answers that in lines 3-55 of column 8 McCollom teaches that upon detecting that the ad displayed has been activated, the consumer program sends statistical information, (such as the number of times the user has clicked on the advertisement to obtain further information from the merchant website), to a commerce server. Once the consumer has sent all the statistical information captured from the consumer interaction, the consumer requests and receives from the commerce server, all advertisements from each merchant and in each category. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was

made, to know that the consumer browser would be dynamically tailored to the moment

the commerce server receives the statistical information and from this information, the

server would customize the advertisements that are sent to the consumer. This way

each consumer would receive only advertisement that is better targeted to his/her

needs.

For the above reasons, it is believed that the rejections should be sustained.
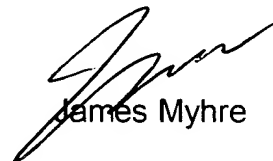
Respectfully submitted,

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